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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,890	12/10/2003	James R. Lisk JR.	2C03.1-141	6906

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SUITE 800
ATLANTA, GA 30339

EXAMINER

MENDOZA, MICHAEL G

ART UNIT	PAPER NUMBER
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3734

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/732,890

Applicant(s)

LISK ET AL.

Examiner

Michael G. Mendoza

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 22, 23 and 26-32 is/are rejected.
- 7) ☒ Claim(s) 21, 24, 25, 33 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :5/21/04, 1/7/05, 1/24/05, 1/31/05, 2/11/05, 5/9/05, 5/31/05, 10/31/05, 10/31/06 .

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. In claim 1, the Applicant is required to clarify to what the claim is intended to be drawn to, i.e., either the separator alone or the combination of the separator and the surgical device. The Applicant sets forth the combination of the separator and the surgical when describing the parts of the surgical device, i.e., a positioning ring, which is inconsistent with preamble, that sets forth the subcombination of separator. Applicant is required to make the language of the claims consistent with the intent of the claims. It should also be noted that in considering the claims on the merits, the Examiner will consider the claims as drawn to the combination.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 10, 14-16, 22, 27, 31, and 32 are rejected under 35 U.S.C. 102(a) as being anticipated by Levesque et al. 6610075.

6. Levesque et al. teaches a separator for use with a surgical device, the surgical device including a positioning ring 12, a separator 16 assembly structured and disposed to carry the separator 80 across the positioning ring, the separator having a polymeric separating edge; where the separating edge is not sufficiently sharp (see fig. 4); wherein said polymeric separating edge comprises a polymeric material selected from acetals, (meth)acrylates, acrylics, alkyds, polycarbonates, polyolefins, polyesters and co-polyesters, polymethylpentene, polypropylene, polysulfones, cellulosics, styrene acrylic co-polymers, fluoropolymers, nylons, polystyrene, polyetheretherketones (PEEK), polyarylates, polyetherimides, styrene acrylonitrile, silicones, epoxys, polyvinyl chloride, urethanes, acrylonitrile-butadiene-styrene (ABS), methylmethacrylate-acrylonitrile-butadiene-styrene (MABS), allyl diglycolcarbonate, and combinations thereof (Nylon is a polycarbonate); wherein said polymeric separating edge comprises a polymeric material selected from polycarbonates, PEEK, polystyrenes, MABS, acetal homopolymers, PMMA, and combinations thereof (nylon is a polycarbonate); wherein polymeric separating edge comprises a transparent material (col. 10, lines 30-32); and at least one surface feature for coupling with a surgical device (see fig. 9)

7. Claims 1-4, 14-16, 27, 31, and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Carriazo 6447526.

8. Carriazo teaches a separator for use with a surgical device, the surgical device including a positioning ring 13, a separator 7 assembly structured and disposed to carry the separator across the positioning ring, the separator having a polymeric separating edge; where the separating edge is not sufficiently sharp (see figs. 1 & 2); wherein said polymeric separating edge comprises a polymeric material selected from acetals, (meth)acrylates, acrylics, alkyds, polycarbonates, polyolefins, polyesters and co-polyesters, polymethylpentene, polypropylene, polysulfones, cellulose, styrene acrylic co-polymers, fluoropolymers, nylons, polystyrene, polyetheretherketones (PEEK), polyarylates, polyetherimides, styrene acrylonitrile, silicones, epoxys, polyvinyl chloride, urethanes, acrylonitrile-butadiene-styrene (ABS), methylmethacrylate-acrylonitrile-butadiene-styrene (MABS), allyl diglycolcarbonate, and combinations thereof (TEFLON is a fluoropolymer); wherein said polymeric separating edge comprises a polymeric material selected from polycarbonates, PEEK, polystyrenes, MABS, acetal homopolymers, PMMA, and combinations thereof (TEFLON is a polycarbonate); and and at least one surface feature for coupling with a surgical device (see fig. 3).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5-8, 11, 17-20, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levesque et al.

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11. Levesque et al discloses the claimed invention except for the physical limitations recited in claims 5-8, 11, 17-20, and 23. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the limitations, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

12. Claims 26 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levesque et al.

13. Levesque et al. discloses the claimed invention except for the leading edge portion size range. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed range limitations, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

14. Claims 5-8, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carriazo.

15. Carriazo discloses the claimed invention except for the physical limitations recited in claims 5-8 and 17-20. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the limitations, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

16. Claims 26 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carriazo.

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17. Carriazo discloses the claimed invention except for the leading edge portion size range. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed range limitations, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Allowable Subject Matter

18. Claims 21, 24, 25, 33, and 34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael G. Mendoza whose telephone number is (571) 272-4698. The examiner can normally be reached on Mon.-Fri. 9:00 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hayes can be reached on (571) 272-4959. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MM

A handwritten signature in black ink, appearing to read "MJ Hayes", is positioned above the printed name and title.

MICHAEL J. HAYES
SUPERVISORY PATENT EXAMINER